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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,584	02/28/2008	Kenichi Nagayama	46969-5447	7384
55694 7590 02/18/2009 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
TRAN, TAN N				
ART UNIT		PAPER NUMBER		
2826				
MAIL DATE		DELIVERY MODE		
02/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/586,584

**Applicant(s)**

NAGAYAMA, KENICHI

**Examiner**

TAN N. TRAN

**Art Unit**

2826

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on response filed on 01/23/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 10-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 02/28/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I, claims 1, 2, 4 – 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### **Priority**

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 01/21/2004. It is noted, however, that applicant has not filed a certified copy of the Japan application as required by 35 U.S.C. 119(b).

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

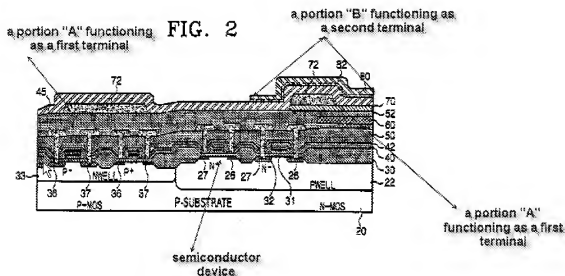
(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 - 8 are rejected under 35 U.S.C. 102(c) as being anticipated by Beak (2004/0119788).

With regard to **claim 1**, Beak discloses a semiconductor apparatus (fig. 2) comprising a substrate (20), a semiconductor device formed on the semiconductor substrate (20), and a protective film (80) for sealing the semiconductor device, the semiconductor apparatus further comprising:

a first conductive layer (72) in contact with a back surface of the protective film (80); and

a second conductive layer (82) in contact with a front surface of the protective film (80).



With regard to **claim 2**, Beak discloses an insulating film (52) of electrical insulation formed on the semiconductor device, the first conductive layer (72) being formed on the insulating film (52).

With regard to **claim 4**, Beak discloses at least one of the first and second conductive layers (72, 82) is patterned into stripes.

With regard to **claim 5**, Beak discloses the first conductive layer (72) and the second conductive layer (82) are patterned into stripes so as to cross each other (the conductive layer “72” formed along a direction perpendicular to the cross sectional view, while the second conductive layer “82” formed along a direction of the protective layer 80 in the cross sectional view).

With regard to **claim 6**, Beak discloses a first electrode terminal (referred to as a portion “A” by examiner’s annotation shown in fig. 2 above, a portion “A” of layer 72 can be functioned as the first terminal) in connection with the first conductive layer; and a second electrode terminal (referred to as a portion “B” by examiner’s annotation shown in fig. 2 above, a portion “B” of layer 82 can be functioned as the second terminal) in connection with the second conductive layer. (Note fig. 2 above of Beak).

With regard to **claim 7**, Beak discloses the first and second electrode terminals (the portions “A” and “B”) are formed on a peripheral part of the substrate (20), the peripheral part being located outside an area in which the semiconductor device is formed.

With regard to **claim 8**, Beak discloses at least one of the first electrode terminal “A” and the second electrode terminal “B” is made of a plurality of electrode pieces (portions “A” and “B”) arranged at predetermined intervals along a peripheral part of the semiconductor substrate (20). (Note fig. 2 above of Beak).

5. Claims 1, 2, 4, 6, 7, 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki et al. (6,955,953).

With regard to **claim 1**, Yamazaki et al disclose a semiconductor apparatus (fig. 1) comprising a substrate (101), a semiconductor device formed on the semiconductor substrate (101), and a protective film (135) for sealing the semiconductor device, the semiconductor apparatus further comprising:

a first conductive layer (130, 133, 134) in contact with a back surface of the protective film (135); and

a second conductive layer (136) in contact with a front surface of the protective film (135).

With regard to **claim 2**, Yamazaki et al disclose an insulating film (129) of electrical insulation formed on the semiconductor device, the first conductive layer (130, 133, 134) being formed on the insulating film (129).

With regard to **claim 4**, Yamazaki et al discloses at least one of the first and second conductive layers (133, 134, 136) is patterned into stripes.

With regard to **claim 6**, Yamazaki et al disclose a first electrode terminal (a portion “130” of layer 134 can be functioned as the first terminal) in connection with the first conductive layer; and a second electrode terminal (a portion of layer 136 can be functioned as the second terminal) in connection with the second conductive layer.

With regard to **claim 7**, Yamazaki et al discloses the first and second electrode terminals are formed on a peripheral part of the substrate (101), the peripheral part being located outside an area in which the semiconductor device is formed.

With regard to **claim 9**, Yamazaki et al the semiconductor device includes an electroluminescent device (column 1, lines 10 – 16).

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN N. TRAN whose telephone number is (571) 272-1923. The examiner can normally be reached on 8:30-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PURVIS SUE can be reached on (571) 272-1236. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TAN N TRAN/

Examiner, Art Unit 2826